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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,556	01/18/2002	Kyoko Kimpara	072982-0233	6102

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EXAMINER

VO, HUYEN X

ART UNIT PAPER NUMBER

2655

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/050,556

Applicant(s)

KIMPARA, KYOKO

Examiner

Huyen X. Vo

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/18/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant has submitted an amendment, filed 12/15/2005, amending the base claims while arguing to traverse prior art rejection based on a limitation regarding “*retranslation instruction part*” (last paragraph on page 9 and first paragraph on page 10) and amended limitations (see claim language). Applicant’s argument has been fully considered. However, upon further consideration, a new ground(s) of rejection is made in view of applicant’s admitted prior art necessitated by claim amendment.

### ***Claim Objections***

2. Claim 7 is objected to because of the following informalities: claim 7 depends on claim 4 and is a duplicate of claim 4. Applicant is advised to replace the program storage medium with a computer-readable medium. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 14-15 drawn to a “program” *per se* as recited in the preamble and as

Art Unit: 2655

such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2655

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 7-8, 11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art (Background of the Invention section).

8. Regarding claims 1, 8, and 14, applicant's admitted prior art discloses a translation server, method, and program storage medium connected to a user terminal via a network, comprising: an input information controller for receiving a translation instruction sent from the terminal, the translation instruction including location information representing a location of an object document to be translated, source language information representing an source language of the object document and target language information representing a translation target language of the object document, and obtaining the object document to be translated from a Web server on the basis of the location information (*referring to figure 1 and/or pages 2-3 of the Background section*); an information separator for separating the object document sent from the input information controller into a translation object part and a non-translation object part (*referring to figure 1 and/or pages 2-3 of the Background section*); a translator for translating the translation object part sent from the information separator according to the source language information and the target language information to obtain a translation result (*referring to figure 1 and/or pages 2-3 of the Background section*); an information converter for producing a retranslation instruction part for permitting the terminal to display a language information input column for inputting the

source language information and the target language information by the user and a retranslation instruction input part and, upon operation of the retranslation instruction input part, to send the translation instruction including the source language information and the target language information in the language information input column and the location information of the object document to be translated to the translation server *(referring to figure 1 and/or pages 2-3 of the Background section. It is inherent that in case the user designates a wrong source/target language or wrong location of the object document, undesired translation or no translation would be carried out by the system. And thus the user must re-enter the desired source/target language and/or location of the desired object document to be translated in order to obtain a desired translation result. The claim language fails to specify how the step of retranslation is different from the prior art of record)*; and an information synthesizer for assembling the translation result sent from the translator, the retranslation instruction part produced by the information converter and the non-translation object part sent from the information separator and sending a synthesized result to the terminal *(referring to figure 1 and/or pages 2-3 of the Background section)*.

9. Regarding claims 4, 7, and 11, applicant's admitted prior art further disclose that the object document to be translated is a hypertext markup language document, wherein the translation object part is a text part *(pages 2-3 of the Background section)*, wherein the non-translation object part is a tag part *(pages 2-3 of the Background section)*.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 5, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (Background of the Invention section) in view of Fushimoto et al. (US 5742505).

12. Regarding claims 2 and 9, applicant's admitted prior art fails to specifically disclose the translation server and method claimed in claims 1 and 8, respectively, wherein the language information input column includes an source language information list box for selecting one of a plurality of source language information and a target language information list box for selecting one of a plurality of target language information and the information converter sets or resets at least both of the source language information and the target language information of the translation instruction to initial values for the source language information list box and the target language information list box, respectively. However, Fushimoto et al. teach a box containing a list of source languages and target languages readily available for user selection and

resetting at least both source language information and the target language information of the translation instruction to initial values (*figures 14, 17 and 18A-C*).

Since applicant's admitted prior art and Fushimoto et al. are analogous art because they are from the same field of endeavors, it would have been obvious to one of ordinary skill in the art at the time of invention to modify applicant's admitted prior art by incorporating the teaching of Fushimoto et al. in order to enable the users of different nationalities to use the system.

13. Regarding claims 5 and 12, applicant's admitted prior art further disclose that the object document to be translated is a hypertext markup language document, wherein the translation object part is a text part (*pages 2-3 of the Background section*), wherein the non-translation object part is a tag part (*pages 2-3 of the Background section*).

14. Claims 3, 6, 10, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Murata et al. (US 5987402).

15. Regarding claims 3, 10, and 15, applicant's admitted prior art fails to specifically disclose the information converter converts from link target document location information representing a location of a link target document included in the non-translation object part to a link target document translation instruction part for permitting the terminal to send the translation instruction including the source language information and the target language information in the language information input column and the



link target document location information to the translation server when the link target document is selected, the information synthesizer assembles the translation result sent from the translator, the retranslation instruction part produced by the information converter and the converted non-translation object part after the conversion of the link target document location information into the link target document translation instruction part in the information converter and sends an assembled result to the terminal.

Murata et al. teach that the information converter converts from link target document location information representing a location of a link target document included in the non-translation object part to a link target document translation instruction part for permitting the terminal to send the translation instruction including the source language information and the target language information in the language information input column and the link target document location information to translation server when the link target document is selected, the information synthesizer synthesizes the translation result sent from the translator, the retranslation instruction part produced by the information converter and the converted non-translation object part after the conversion of the link target document location information into the link target document translation instruction part in the information converter and sends a synthesized result to the terminal (*col. 9, lines 36 to col. 11, line 40 and/or referring to figures 7-11*).

Since applicant's admitted prior art and Murata et al. are analogous art because they are from the same field of endeavors, it would have been obvious to one of ordinary skill in the art at the time of invention to modify applicant's admitted prior art by

incorporating the teaching of Murata et al. in order to enable the server to locate the object document to be translated for the terminal device.

16. Regarding claims 6 and 13, applicant's admitted prior art further disclose that the object document to be translated is a hypertext markup language document, wherein the translation object part is a text part (*pages 2-3 of the Background section*), wherein the non-translation object part is a tag part (*pages 2-3 of the Background section*).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen X. Vo whose telephone number is 571-272-7631. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HXV

2/20/2006

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**RICHEMOND DORVIL**  
**SUPERVISORY PATENT EXAMINER**